



1652 #8
#1-1583

PATENT
Customer No. 22,852
Attorney Docket No. 08702.0090-04000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SULLIVAN *et al.*

Serial No.: 09/878,574

Filed: June 11, 2001

For: HUMAN GDP-MANNOSE
4,6-DEHYDRATASE

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) Group Art Unit: 1652
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) Examiner: Yong D. Pak
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Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated July 26, 2002, the Examiner required restriction under 35 U.S.C. § 121 between:

- Group I - Claim 9, drawn to a method of identifying an inhibitor of GM4,6D activity
- Group II - Claims 21, 26-29, drawn to a method of treating a subject having an inflammatory disorder characterized by aberrant GM4,6D activity with a modulator that comprises of an antibody against GM4,6D
- Group III - Claims 21, 26-28 and 30-32, drawn to a method of treating a subject having an inflammatory disorder characterized by aberrant GM4 6D activity with a modulator that comprises of the polypeptide encoded by SEQ ID NO: 1
- Group IV - Claims 22, 26-29, drawn to a method of treating a subject having a disorder characterized by aberrant cellular fucosylation with a modulator that comprises of an antibody against GM4,6D

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- Group V - Claims 22, 26-28 and 30-32, drawn to a method of treating a subject having disorder characterized by aberrant cellular fucosylation with a modulator that comprises of the polypeptide encoded by SEQ ID NO: 1
- Group VI - Claims 23, 27-29, drawn to a method for modulating an inflammatory response in a subject with a modulator that comprises of an antibody against GM4,6D
- Group VII - Claims 23, 27-28 and 30-32, drawn to a method for modulating an inflammatory response in a subject with a modulator that comprises of polypeptide encoded by SEQ ID NO: 1
- Group VIII - Claims 24, 27-29, drawn to a method for modulating cellular fucosylation in a subject with a modulator that comprises of an antibody against GM4,6D
- Group IX - Claims 24, 27-28 and 30-32, drawn to a method for modulating cellular fucosylation in a subject with a modulator that comprises of the polypeptide encoded by SEQ ID NO: 1
- Group X - Claims 21 and 33-37, drawn to a method of treating a subject having an inflammatory disorder characterized by aberrant GM4, 6D activity with a modulator that comprises of the nucleotide sequence of SEQ ID NO: 1
- Group XI - Claims 22 and 33-37, claims 22, 26-29, drawn to a method of treating a subject having an disorder characterized by aberrant cellular fucosylation with a modulator that comprises of the nucleotide sequence of SEQ ID NO: 1
- Group XII - Claims 23 and 33-37, drawn to a method for modulating an inflammatory response in a subject with a modulator that comprises of the nucleotide sequence of SEQ ID NO: 1
- Group XIII - Claims 24 and 33-37, drawn to a method for the treatment of a disease resulting from increased cell death with Invention III with a modulator that comprises of the nucleotide sequence of SEQ ID NO: 1

Applicants provisionally elect with traverse to prosecute Group II, claims 21, 26-29 drawn to a method of treating a subject having an inflammatory disorder. Applicants submit that Groups II, IV, VI, and VII must be joined and examined together in this

application. Each of Groups II, IV, VI, and VII are designated by the examiner as classified in class 424, subclass 130.1. For a restriction requirement to be proper, a showing of serious burden on the examiner is required. A serious burden may be *prima facie* shown by separate classification, separate status in the art, or a different field of search. See Manual of Patent Examining Procedure (MPEP) §§ 802-803. When inventions are classified in the same class and subclass, as is the case here, MPEP § 802.02 requires the examiner to show different fields of search, e.g., that it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists. The examiner has not made a *prima facie* showing that such a different field of search exists. Where the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. MPEP § 802. Thus, Applicants request the restriction requirement as to Groups II, IV, VI, and VII be withdrawn as improper.

A petition for a four month extension of time and appropriate fees are attached with this response. Please charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: December 20, 2002

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